REMARKS

I.   General

Claims 1 – 4, 6 – 19, 21 – 27, 30 – 34 and 37 – 46 are pending in the application. Claims 1 – 4, 6 – 19, 21, 22, 33, 34, and 37 – 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,628,249 issued to Cordery et al (hereinafter "Cordery") in view of U.S. Pat. No. 5,873,073 issued to Bresnan et al (hereinafter "Bresnan"). Claims 23 – 27 and 30 – 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bresnan. Claim 11 is objected to because of informalities.

Applicant has amended claim 11 to address the objection to this claim. Specifically, claim 11 has been amended to recite "at least one of" rather than the objected to term "and/or." This amendment does not alter the scope of the claim and has introduced no new matter.

Applicant has amended claim 32 to correct an informality discovered during the preparation of this Amendment. Specifically, claim 32 has been amended to recite "date of mailing" instead of "data of mailing." The amendment to claim 32 has introduced no new matter and does not alter the scope of the claim as a minor informality was corrected by the amendment.

II.   Rejections under 35 U.S.C. § 103(a) as being unpatentable over Cordery in view of Bresnan

Claims 1 – 4, 6 – 19, 21, 22, 33, 34 and 37 – 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cordery in view of Bresnan. The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. M.P.E.P. 2142; In re Peehs, 612 F.2d 1287, 204 USPQ 835, 837 (CCPA 1980). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of

success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

For each rejected claim, Examiner fails to satisfy, at least, the requirements that (1) the applied art teaches all claim limitations and (2) that there is proper motivation for one of ordinary skill in the art to have combined the references.

A.   The Independent Claims

1.   Claim 1

a.   Bresnan does not teach the limitations that Examiner concedes Cordery lacks

Examiner concedes "Cordery et al does not expressly disclose using at least some of said abstracted data [bits] for controlling at least one of said additional functions, wherein said at least one of said additional functions comprises printing of a postage indicia, and wherein said at least one additional function further comprises accepting data from a source other than said data stream; and creating, from said abstracted data a separate data stream for controlling the printing of said postage indicia." Office Action, page 5. Examiner relies on Bresnan for these limitations of claim 1 in arguing the obviousness of claim 1. *Id.*

Examiner's citation to Bresnan does not teach using "abstracted data bits for controlling ... additional functions, wherein ... said ... additional function further comprises accepting data from a source other than said data stream...." Examiner's citation to col. 4, lines 15 – 17 merely teaches that the unfinished mail piece is franked by a postage meter. It does not teach using abstracted data bits from a data stream to control a function that accepts data from another source than said data stream to create the postage indicia. Similarly, nowhere in Figure 2, as cited by Examiner, does it teach or suggest the limitations of claim 1. In fact, Figure 2 teaches that the parsed job request (106, Figure 2) is used only to either (1) print documents (116, Figure 2) or (2) print envelopes (112, Figure 2).

Absent a teaching or suggestion of the limitations of claim 1 in Bresnan, Examiner has sought to address this deficiency by arguing the limitation is inherent. Office Action, page 6. Examiner argues that because Bresnan states a mailpiece is franked with appropriate postage by a postage meter then "it is **inherent** that other data must be sent to the mailing

machine to properly frank the mailpieces" and "[t]herefore, it is clear to see that the mailing machine accepts data from sources other than the job request data stream ...." Office Action, pages 5 – 6 (emphasis added); Bresnan, col. 4, lines 14 -17. Based on the alleged inherent teaching of Bresnan, Examiner then concludes it would have been obvious to modify Cordery to include a postage-printing feature. Office Action, page 6. Applicant traverses Examiner's assertion that using "abstracted data bits for controlling ... additional functions, wherein ... said ... additional function further comprises accepting data from a source other than said data stream ..." is inherent to Bresnan.

"Inherency . . . may not be established by probabilities or possibilities." *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981). In other words, for Examiner to demonstrate that a missing limitation is inherent to an invention, Examiner has to show the missing limitation must necessarily be present in the invention. *See Continental Can Co. U.S.A. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991) (citing *In re Oelerich*). Examiner has not shown that some function, in Bresnan, necessarily use "abstracted data bits for controlling ... additional functions, wherein ... said ... additional function further comprises accepting data from a source other than said data stream...."

Rather, Examiner has asserted that data required for producing postage indicia can be obtained from certain devices such as a meter linking device, a weighing scale etc. Office Action, page 5. However, one possibility is that, the user "creates a job request" including the information required to produce a postage indicia. *See* Col. 3, 49 – 56; 100, 102, 104, 106, Figure 2; *see e.g.* col. 7, lines 5 – 8 (reciting that the user enters the class of postage during the creation of a job request). In such a case, there would be one data stream, which includes the data needed to produce the postage indicia. Because this is at least one possibility, then "abstracted data bits for controlling ... additional functions, wherein ... said ... additional function further comprises accepting data from a source other than said data stream..." has not been shown to be inherent to the disclosure of Bresnan.

Even if Bresnan teaches all Examiner asserts Bresnan teaches with regard to claim 1, the teaching of Bresnan would still not encompass all the teachings of claim 1. Examiner asserts, "the parsed job order is a data stream." Office Action, page 5. Therefore, to teach the limitations of claim 1, the data accepted from other sources in Bresnan (assumed for illustration only) would be controlled by abstracted data bits from "the parsed job order"—

Bresnan's data stream, to create a postage indicia. However, nowhere in Bresnan, as cited by Examiner, is there any abstracting of data bits from "the parsed job order." Consequently, Examiner has failed to show that Bresnan teaches all the limitations of claim 1, even if it were true that accepting data from other sources, is inherent to Bresnan.

        b.   An inherent teaching is not sufficient to establish a prima facie case of obviousness

Even if the teaching of Bresnan, as asserted by Examiner, is inherent, the obviousness rejection of claim 1 based on inherency is improper. "Inherency and obviousness are distinct concepts. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Dillion*, 919 F.2d 688, 16 USPQ2d 1897, 1922 (Fed. Cir. 1990) (en banc) (Newman, J., dissenting), cert. denied dub nom. *Dillion v. Mannbeck*, 500 U.S. 904 (1991). Because the teaching "accepting data from a source other than said data stream ..." cannot reasonably be considered "known," on reading Bresnan as cited by Examiner, this alleged inherent teaching of Bresnan, cannot stand as a basis for showing a prima facie case of obviousness of claim 1.

        c.   Lack of suggestion or motivation

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *See In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1783. Neither Cordery nor Bresnan alone or in combination, provides any teaching or suggestion supporting the modification of Cordery by the teachings of Bresnan. *See generally* Cordery; Bresnan.

Bresnan's objective is to allow a small business that cannot afford the necessary equipment, to use the equipment of centralized data center to produce mailpieces. Col. 1, 39 – 42. In Bresnan, the system user defines a mail piece remotely, via modem, by selecting certain characteristics and then downloading this data to the centralized data center where the mail piece is produced. Bresnan, Col. 2, lines 10 – 14. On the other hand, Cordery's object is to "provide an apparatus and method for producing moderately sized mail runs of a high quality, and which is suitable for use in an office environment with standard microcomputers and word processing programs." Cordery, Col. 1, 55 – 59. The significant difference in the

objectives of Bresnan and Cordery, would not motivate one skilled in the art to modify Cordery by Bresnan. Examiner, therefore, in modifying Cordery and Bresnan, is impermissibly using claim 1 as an instruction manual to piece together the alleged teachings of Cordery and Bresnan to render claim 1 obvious. *See In re Fritch*, 23 USPQ2d at 1784.

Accordingly, Cordery and Bresnan do not teach all the limitations of claim 1 or provide a suggestion or motivation for the modification of Cordery by the teachings of Bresnan. Therefore, Cordery in view of Bresnan does not render claim 1 obvious under 35 U.S.C. § 103(a).

2. Claim 17

Claim 17 recites, in part, "using at least some of said abstracted data bits for controlling at least one of said additional functions, wherein said at least one of said additional functions comprises printing of a postage indicia;" and "creating, from said abstracted data bits, a separate data stream for controlling the printing of said postage indicia ...." Examiner concedes Cordery does not teach these limitations. Office Action, page 9. Bresnan, col. 7, lines 5 – 8 and col. 18, lines 63 – 67, on which Examiner relies, does not teach, said limitations of claim 17.

In fact, Examiner does not assert the cited portions of Bresnan teach these limitations of claim 17. Rather, Examiner states Bresnan comprises certain elements such as a meter-linking device etc. and then proceeds to conclude "[t]herefore it would have been obvious ... to modify Cordery et al's invention to include a postage printing feature." Office Action, page 9. Merely stating Bresnan comprises certain devices does not equate to showing Bresnan teaches "using at least some of said abstracted data bits for controlling at least one of said additional functions, wherein said at least one of said additional functions comprises printing of a postage indicia;" and "creating, from said abstracted data bits, a separate data stream for controlling the printing of said postage indicia" as recited in claim 17. Because Examiner has not shown how Bresnan teach the deficiencies of Cordery, Examiner's conclusion that it is obvious to modify Cordery to render claim 17 obvious is improper.

Claim 17 also recites, in part, "wherein said printer driver is operable on said data stream coming from a program operating in a computing device to control at least a portion

of the printing of said printer, wherein said abstracting includes examining said data stream
for preestablished data patterns, and wherein said preestablished data patterns include the
beginning and ending of postage indicia data." Examiner has sought to show "said
preestablished data patterns include the beginning and ending of postage indicia data"—only
a part of the limitation of claim 17. Office Action, page 10. Examiner has not sought to
show "wherein said printer driver is operable on said data stream coming from a program
operating in a computing device to control at least a portion of the printing of said printer,
wherein said abstracting includes examining said data stream for preestablished data
patterns." Examiner must show that the complete limitation, and not part of it, is taught by
the applied art to establish a case of prima facie obviousness.

With respect to the part of the limitation Examiner seeks to address, Examiner
concedes, "Cordery et al does not expressly disclose wherein said preestablished data patterns
include the beginning and ending of postage indicia data." Office Action, page 10.
Examiner, nonetheless, further argues it would have been obvious to modify Cordery. *Id.*
However, the mere fact that the prior art may be modified in the manner suggested by the
Examiner does not make the modification obvious unless the prior art suggested the
desirability of the modification. *See In re Fritch*, 23 USPQ2d at 1783. Here, Examiner has
not shown there is any suggestion in the applied art for the modification Examiner proposes.
Examiner, therefore, in modifying Cordery is impermissibly using claim 17 as an instruction
manual to piece together the alleged teachings of Cordery to render claim 17 obvious.

3.   Claim 33

Examiner rejects claim 33 for the same reasons as claim 1. Office Action, page 4.
Claim 33 recites, in part, "an abstracting program operable for reviewing said data stream to
obtain therefrom a separate data stream for controlling additional printing operations
ancillary to said printing operation, wherein said one ancillary operation further comprises
the acceptance of data from a source other than said data stream." Examiner does not refer
to any part of Cordery or Bresnan that teaches this limitation of claim 33. Rather, Examiner
has argued that "it is inherent that other data must be sent to the mailing machine ...." Office
Action, page 6. As discussed with regard to claim 1, Examiner has not shown the inherency
of Bresnan as Examiner argues, and additionally, inherency is not a proper basis for an
obviousness rejection. Moreover, Examiner has sought to assert the teaching of only a part of

the limitation in question. Examiner has not shown the applied art teaches "an abstracting program operable for reviewing said data stream to obtain therefrom a separate data stream for controlling additional printing operations ancillary to said printing operation." Therefore, Examiner has not shown that the applied art teaches this limitation of claim 33.

Further, Claim 33 also recites "a controller working in cooperation with said abstracting program and with said separate data stream for enabling at least one said ancillary printing operation, wherein said at least one ancillary operation comprises the printing of a postage indicia on material separate from material on which printing of said information is occurring." Examiner has not asserted that any part of Cordery or Bresnan teaches this limitation. Instead, Examiner argues it would have been obvious to modify Cordery based on the alleged inherent teachings of Bresnan to "include postage printing feature." Office Action, page 6. As with the previous limitation of claim 33, the inherency, as argued by Examiner, of Bresnan, has not been established and is not a proper basis of an obviousness rejection. Furthermore, Examiner's assertions do not address the entire limitation at issue. Specifically, Examiner has not asserted that the applied art teaches "a controller working in cooperation with said abstracting program and with said separate data stream for enabling at least one said ancillary printing operation." Therefore, Examiner has not shown the applied art teaches this limitation of claim 33.

4.   Claim 41

Claim 41 recites, in part, an abstracting program operable for reviewing said data stream to obtain therefrom a separate data stream for controlling additional printing operations ancillary to said printing operation and a controller working in cooperation with said abstracting program and with said separate data stream for enabling at least one said ancillary printing operation, wherein said at least one ancillary operation comprises the printing of a postage indicia on material separate from material on which printing of said information is occurring." Examiner concedes Cordery does not expressly recite the limitations of claim 41. Office Action, page 9.

Examiner relies on the teaching of Bresnan that states Bresnan comprises certain devices such as a meter linking device. *Id.* Similar to the discussion with regard to claim 17, merely reciting the devices used in Bresnan does not equate to showing Bresnan teaches the

limitations of claim 41. Because Examiner has not shown Bresnan teaches the limitations of claim 41, Examiner cannot properly assert Bresnan is a basis for modifying Cordery in order to render claim 41 obvious.

Claim 41 also recites "wherein said abstracting program includes a control program for examining said data stream for certain preestablished data patterns, and wherein said certain preestablished data patterns include the beginning and ending of postage indicia data." Examiner concedes, "Cordery et al does not expressly disclose wherein said preestablished data patterns include the beginning and ending of postage indicia data." Office Action, page 9. Examiner, nonetheless, argues it would have been obvious to modify Cordery to meet this limitation. *Id.* However, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *See In re Fritch*, 23 USPQ2d at 1783. Here, Examiner has not shown there is any suggestion in the applied art for the modification Examiner proposes. Examiner, therefore, is impermissibly using claim 41 as an instruction manual to piece together the alleged teachings of Cordery to render claim 41 obvious.

B.   The Dependent Claims

Dependent claims 2 – 4, 6 – 16, 18, 19, 21, 22, depend from base claim 1. Dependent claims 34, 37 – 40 and 42 – 46 depend from base claim 33. The dependent claims each inherit all the limitations of their respective base claims and for at least this reason are patentable. Moreover, the dependent claims recite additional new and non-obvious limitations not disclosed by the applied art.

For example, with regard to claim 4, Examiner concedes, Cordery "does not expressly disclose at least one additional function further comprises a dialog box for allowing options from a user." Office Action, page 7. Examiner relies on Figure 4 of Bresnan for this limitation. *Id.* However, merely pointing to Figure 4, which shows a dialog box used in one of the steps in Bresnan, does not show that Bresnan uses a dialog box as required in claim 4. In claim 4, the dialog box for allowing options from a user, is controlled by data bits abstracted from a data stream. Figure 4 does not illustrate abstracted data bits controlling the dialog box and therefore Bresnan does not disclose the limitations of claim 4.

In addition to failing to show Bresnan teaches the deficiencies of Cordery, Examiner has not cited any part of Cordery or Bresnan that teaches or suggests the combination of Cordery and Bresnan. Examiner, therefore, in combining Cordery and Bresnan, is impermissibly using claim 4 as an instruction manual to piece together the alleged teachings of Cordery and Bresnan to render claim 4 obvious. *See In re Fritch*, 23 USPQ2d at 1784.

With regard to claim 6, Examiner asserts that Cordery discloses, "at least one additional function further comprises directing the abstracted portion to multiple locations." Office Action, page 7. Examiner cites to col. 4, lines 25 – 34. However, col. 4, lines 25 – 34 merely discloses the printer controller sends the attribute data to the mail finishing unit controller and sends the document data to the document printer engine. Examiner has not identified which of the document data or attribute data equates to the "abstracted portion" as recited in claim 6. In any event, Examiner's citation to Bresnan indicates that both document data and the attribute data are sent to a single destination. Therefore, Cordery, as cited by Examiner, does not teach, "directing the abstracted portion to multiple locations."

With regard to claim 7, Examiner asserts Cordery discloses "at least one additional function further comprises storage in a memory (every computer device must have a memory)." Office Action, page 7. Examiner has merely asserted that all computers have memory. Examiner has failed to show that Cordery teaches at least one additional function controlled by the abstracted data, comprises storage in a memory.

With regard to claim 8, Examiner asserts Cordery discloses, "at least one additional function further comprises directing the abstracted portion to a viewable medium." Office Action, page 7. Examiner cites to col. 41 – 51. *Id.* There is no col. 41 – 51 in Cordery. Examiner has failed to show where Cordery teaches the limitation of claim 8.

With regard to claim 10, Examiner asserts Cordery discloses, "at least one additional function further comprises the delivery of said data to a location remote from said printer driver." Office Action, page 7. In the citation Examiner uses to support this assertion, Cordery merely teaches the printer controller sends the attribute data to the mail finishing unit controller and sends the document data to the document printer engine. *See Id.*; col. 4, lines 25 – 34. Examiner has not identified whether the document data or the attribute equates to

claim 10's data. Furthermore, nowhere does Examiner's citation of Cordery teach, "delivery of any data to a location remote from said printer driver."

With regard to claim 11, Examiner cites to col. 4, lines 25 – 34 to support the assertion that Cordery discloses, "at least one additional function further comprises the change in location and/or format of the data based upon an interaction between certain data in said data stream and data stored in said printer driver." Office Action, page 7 – 8. The portion of Cordery to which Examiner cites, teaches the printer controller sends the attribute data to the mail finishing unit controller and sends the document data to the document printer engine. Col. 4, lines 29 – 34. Examiner has not identified what the document data or the attribute equates to in claim 11. Examiner, therefore, has failed to show how the cited portion of Bresnan teaches the limitations of claim 11.

With regard to claim 14, Examiner concedes "Cordery et al does not expressly disclose that the printer driver is located within said printer." Office Action, page 8. Nevertheless, Examiner submits, "that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the printer driver be within the printer." Office Action, page 8. Examiner further states, "Cordery et al provides specific motivation from Fig. 3 where the printer controller could be integrated with the print machine by the dotted lines." The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *See In re Fritch*, 23 USPQ2d at 1783. Examiner's reference to Figure 3 does not suggest the desirability of the modification. Examiner has merely asserted there is motivation because "the printer controller **could** be integrated with the print machine...." Office Action, page 8 (emphasis added). Examiner, therefore, is impermissibly using claim 14 as an instruction manual to modify Cordery in order to render claim 14 obvious.

Claim 19 recites, "wherein said preestablished data patterns include the beginning and ending of address information contained within said data stream." Claim 21 recites, "wherein said preestablished data patterns include the beginning and ending of each document to be printed." Examiner relies on Cordery, col. 3, lines 11 – 16 as teaching the limitations of both claims 19 and 21. Office Action, pages 10 – 11. However, the cited portion of Cordery provides, "[e]ach of records ... includes mail piece header 16, document data field 20, and

envelope data field 22. Mail piece header 18 includes the same ... data elements included in job header 12 to define the mailpiece attributes ...." Col. 3, lines 11 – 16. Examiner has not explained how this cited portion of Cordery discloses the abstraction of data from a data stream includes examining said data streams for the preestablished data patterns required in claims 19 and 21. Therefore, Examiner has failed to show that Cordery teaches the limitations of claims 19 and 21.

Claim 39 is rejected for the same reasons as claim 14. Office Action, page 8. Examiner concedes Cordery does not disclose the limitation of claim 39. *Id.* Examiner however argues it would have been obvious to modify Cordery to render claim 39 obvious. As discussed with regard to claim 14, the mere fact that the applied art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the applied art suggested the desirability of the modification. Examiner has failed to explain how Figure 3 suggests the desirability of the modification. In sum, Cordery, does not teach the limitations of claim 39 and additionally, Examiner has failed to show the proposed modification of Cordery is obvious.

With regard to claim 43, Examiner has rejected claim 43 for the same reasons as claim 19. Office Action, page 10. Examiner has not explained how col. 3, lines 11 – 16 of Cordery, cited by Examiner, discloses a computer product that has a control program for examining a data stream for preestablished data patterns that include the beginning and ending of address information contained within said data stream, as required by claim 43. Examiner has therefore failed to show Cordery teaches the limitations of claim 43.

With regard to claim 44, Examiner asserts, "Cordery et al disclose wherein said computer product further contains a program for creating from said address information data for controlling the printing of a postage indicia." Examiner cites to col. 3, lines 41 – 52 in support of this assertion. This cited portion of Cordery teaches about a commercial word processing program which includes an application to merge variable data to be printed on the document and with a predetermined form to create a document data. Col. 3, lines 41 – 48. "The document data is input to driver 37 and driver 37 creates the job data by extracting an address from the document data and accessing data store 38 to define the mail piece attributes." Col. 3, lines 48 – 51. Cordery, as cited by Examiner, does not teach a "computer

product further contains a program for creating from said address information data for controlling the printing of a postage indicia."

With regard to claim 45, Examiner rejects claim 45 for the same reasons as claim 21. Office Action, page 11. Examiner has not shown how col. 3, lines 11 – 16 of Cordery discloses a computer product that has a control program for examining a data stream for preestablished data patterns that include the beginning and ending of each document to be printed.

With regard to claim 46, Examiner asserts "Cordery et al disclose wherein said data patterns are selected from the list including: return address, destination address, mailing date, number of pages, type of inserts, mailing service type, postage indicia, bar codes, tracking codes, control codes." Examiner's citation to Cordery, however, teaches "[j]ob header 12 ... defines default attributes for each mail piece ... including the number of document sheets ... whether or not a pre-printed insert is to [be] added" etc. This citation does not teach a computer product with a control program for examining data patterns selected from the list in claim 46. Therefore, Examiner's citation to Cordery does not teach all limitations of claim 46.

C.   Summary

Based on the above, with regard to claims 1 – 4, 6 – 19, 21, 22, 33, 34 and 37 – 46, Examiner has failed to show Cordery alone or Cordery in view of Bresnan teach all the limitations of the claims. Furthermore, there is no suggestion or motivation to modify Cordery or to combine Cordery and Bresnan. Accordingly, Applicant respectfully requests that Examiner withdraw the objections to claims 1 – 4, 6 – 19, 21, 22, 33, 34 and 37 – 46 under 35 U.S.C. § 103(a) as being unpatentable over Cordery in view of Bresnan.

III.   Rejections under 35 U.S.C. § 103(a) as being unpatentable over Bresnan

Claims 23 – 27 and 30 – 32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bresnan.

A. The Independent Claims

1. Claim 23

Examiner states that Bresnan teaches, "reviewing said data stream to create therefrom a separate data stream for controlling additional functions with respect to printing of documents." Office Action, page 12. Examiner cites to several sections of Bresnan in support of this statement. However, none of these citations to Bresnan teaches the limitations of claim 23.

First, col. 2, lines 25 – 29 points out that the user, in Brensan, can select the characteristics such as the paper type, ink color etc. This is done at a first node as part of the customer initiating a job request. Col. 2, lines 29 – 32. In other words, the data stream is in the process of being created. (100, Figure 2). At this point, in Bresnan, no data stream has yet been sent; therefore, there cannot be a reviewing of the data stream.

Second, col. 4, lines 64 – 67 describes a further step in the initiating of the job request. However, this step in the job request involves setting up the modem that would send the data stream. (100, Figure 2); (200, Figure 3B). Again, at this point, in Bresnan, no data stream has been sent that can be reviewed.

Third, col. 4, lines 14 – 16 teaches the franking of mailpieces with appropriate postage. Therefore, the citation to Bresnan on which Examiner relies, does not teach "reviewing said data stream to create therefrom a separate data stream for controlling additional functions with respect to printing documents" as recited in claim 23.

Examiner concedes, "Bresnan does not expressly disclose wherein said separate data stream includes data accepted from a source other than said data stream to said printing device." Office Action, page 12. However, Examiner then proceeds to make the same "inherency" argument Examiner made with respect to the similar recitation in claim 1. For the reasons discussed with regard to claim 1, Examiner has failed to show the teaching "wherein said separate data stream includes data accepted from a source other than said data stream to said printing device" is inherent to Bresnan. Furthermore, as discussed with regard to claim 1, inherency of a reference is not a proper method of establishing a prima facie case of obviousness.

Examiner cites to col. 2, lines 41 – 43 in support of the assertion that Bresnan recites "deducting said calculated postage amount from said secure memory if said calculated postage amount is available in said secure memory." However, col. 2 lines 41 – 43 teaches "[t]he unfinished mail piece is sealed and then franked with appropriate postage in order to form an unfinished mail piece." Therefore, Bresnan, as cited by Examiner does not teach, "deducting said calculated postage amount from said secure memory if said calculated postage amount is available in said secure memory." Examiner, therefore, has failed to show Bresnan teaches all the limitations of claim 23.

B.   The Dependent Claims

Dependent claims 24 – 27 and 30 – 32 depend from base claim 23. The dependent claims each inherit the limitations of base claim 23 and for at least this reason are patentable. Moreover, the dependent claims recite additional new and non-obvious limitations not disclosed by the applied art.

For example, claim 24 recites, "wherein said additional functions are selected from the list including printing address information, printing postage indicia, folding a printed document, stuffing a printed document into an envelope, creating a mailing address for the delivery of a printed document, creating a postage indicia, creating an auxiliary document in association with a printed document, controlling a second printer operating in conjunction with said printer, verifying the address, normalizing the address, adding delivery bar codes." Bresnan, col. 2, lines 25 – 29, on which Examiner relies, teaches that a system user selects "the characteristics includ[ing] a choice of: paper type; ink color; paper color; paper size; duplex or simplex printing on the chosen paper; a choice of whether or not a reply envelope is to be printed; and a choice of how the chosen paper is to be folded."

In Bresnan, the characteristics chosen by the user is at a first node and is a step in the creation of the data stream. Col. 2, lines 21 – 22. Bresnan, therefore, is different from claim 24 because in claim 24, a data stream is reviewed to create a separate data stream for controlling additional functions which include those outlined in the list in claim 24. Bresnan as cited by Examiner, therefore, does not teach the limitations of claim 24.

With regard to claim 25, Examiner asserts "copying from said data stream portions of said data stream" is taught by col. 3, lines 60 – 68 of Bresnan. Office Action, page 14. This citation to Bresnan, however, simply teaches the parsing of data based on whether the data presented is an address field. The citation does not teach a reviewing step that includes copying from the data stream portions of the data stream.

With regard to claim 27, Examiner cites to Bresnan, col. 7, lines 5 – 8, for the limitation "creating from said copied address information a postage indicia." However, col. 7, lines 5 – 8 describes steps where the class of postage is entered and then the advancement to a query step. Examiner's citation does not teach "creating from said copied address information a postage indicia."

With regard to claim 32, Examiner cites Fig. 5A as teaching "wherein said dialog box interacts with a user to provide at least one of the following: return address and logo; date of mailing; address verification/prompt for insufficient information; review scanned data; hints for scanning data stream; additional cover page information or label/envelope customization; delivery (mail service, fax, e-mail, etc.); and options (postage amount, paper weight, weight of inserts, additional mail services)." Figure 5A merely shows Bresnan use dialog boxes. Figure 5A does not show that the dialog box interaction with the user is part of the reviewing of the data stream to create a separate data stream for controlling additional functions. Therefore, Examiner has failed to show Bresnan teaches at least this limitation of claim 32.

C.   Summary

For the reasons described above, claims 23 – 27 and 30 – 32 are patentable. Accordingly, Applicant respectfully requests that Examiner withdraws the rejections of claims 23 – 27 and 30 – 32 under 35 U.S.C. 103(a) as being unpatentable over Bresnan.
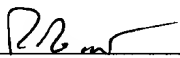
IV.   Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 61135/P016US/10106022 from which the undersigned is authorized to draw.

Dated: October 25, 2006

Respectfully submitted,

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